## REMARKS

Claims 12-35 were pending in the present application. By virtue of this response, claim 13 has been cancelled, claims 22 and 31 have been amended, and no new claims have been added. Accordingly, claims 12 and 14-35 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. Claim amendments have been made to correct typographical errors. No new matter has been added.

**Rejections under Non-statutory Double Patenting – General Comments**

Applicant disagrees with the non-statutory double patenting rejections cited below. Applicant notes that the Office Action is rejecting the method claims of the subject application with various device claims in patents assigned to the applicant. In each case, the Office Action fails to elaborate on why such a double patenting rejection is warranted.

Applicant further notes that MPEP §804 recites that "[a]ny obvious-type double patenting rejection should make clear (A)The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and (B)The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of the invention defined in a claim in the patent."

In each case of the rejection below, the Office Action merely recites that given that the device of the patent claims contains a lumen, the patent claims would read on the claimed method. Again, at the very least, the Office Action should make clear the differences between the inventions of the patent claims and the claim in the application and provide reasons why a person of ordinary skill in the art would conclude the invention defined in the claims at issue would have been obvious in view of the invention in the patent claims.

Applicant believes that the double patenting rejections are in error and must be withdrawn. Applicant is submitting herewith a terminal disclaimer for US patent 6,692,494, which is a patent identified in an earlier Office Action. In view of this submission, applicant believes that the claims in this application are now in condition for allowance.

**Rejections under Non-statutory Double Patenting - 7,022,088**

Claims 12-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 7,022,088.

Applicant disagrees with this rejection and believes it is made in error. Claim 1 of the '088 patent recites: "A medical device for applying energy to tissue." The Office Action states that the instant application claims are not patentably distinct from the patent claims because "the use of the device in the patent claims would read on the claimed method, given that the device has a lumen therein."

Applicant notes that claim 1 recites "a method of altering gaseous flow in a lung, comprising, locating a site in the lung for creating a collateral channel; creating the channel in an airway wall of the lung; temporarily inserting a conduit into channel; and subsequently removing the conduit after the channel has healed in an open position. Clearly, the recited method of altering gaseous flow in a lung is quite distinct from a medical device for applying energy to tissue.

Clearly, the claims of the '088 patent define an invention that is a device for applying energy to tissue. In contrast, the subject claims define an invention that is a method of creating a channel, inserting a conduit into the channel, and subsequently removing the conduit after the channel has healed in an open position. In view of these clear differences, applicant requests withdrawal of this rejection.

**Rejections under Non-statutory Double Patenting - 7,022,088**

Claims 12-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 7,175,644.

Applicant disagrees with this rejection and believes it is made in error. Claims 1 and 20 (the only independent claims) of the '644 patent respectively recite: "A implantable conduit for maintaining the patency of an opening in tissue, the conduit being detachable from a balloon catheter for remote implantation within the opening" and "[an] implantable conduit for maintaining the patency of an opening in tissue, the conduit being detachable from a balloon catheter for remote implantation within the opening".

The Office Action states that the instant application claims are not patentably distinct from the patent claims because "the use of the device in the patent claims would read on the claimed method, given that the applicator for device has a lumen therein."

Again, claim 1 recites "a method of altering gaseous flow in a lung, comprising, locating a site in the lung for creating a collateral channel; creating the channel in an airway wall of the lung; temporarily inserting a conduit into channel; and subsequently removing the conduit after the channel has healed in an open position. Clearly, the recited method of altering gaseous flow in a lung is quite distinct from the medical device recited in the patent claims.

Clearly, the claims of the '644 patent define an invention that is an implant device. In contrast, the subject claims define an invention that is a method of creating a channel, inserting a conduit into the channel, and subsequently removing the conduit after the channel has healed in an open position. In view of these clear differences, applicant requests withdrawal of this rejection.

**Rejections under Non-statutory Double Patenting - 6,749,606**

Claims 12-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,749,606.

Applicant disagrees with this rejection and believes it is made in error. Claim 1 of the '606 patent recites: "A medical device for detecting motion within tissue by observing a Doppler shift and for creating channels in tissue".

The Office Action states that the instant application claims are not patentably distinct from the patent because "the use of the device in the patent claims would read on the claimed method, given that the device has a lumen therein."

Again, claim 1 recites "a method of altering gaseous flow in a lung, comprising, locating a site in the lung for creating a collateral channel; creating the channel in an airway wall of the lung; temporarily inserting a conduit into channel; and subsequently removing the conduit after the channel has healed in an open position. Clearly, the recited method of altering gaseous flow in a lung is quite distinct from the medical device recited in the patent claims.

Clearly, the claims of the '606 patent define an invention that is medical device for detecting motion within tissue. In contrast, the subject claims define an invention that is a method of creating a channel, inserting a conduit into the channel, and subsequently removing the conduit after the channel has healed in an open position. In view of these clear differences, applicant requests withdrawal of this rejection.

**Rejections under Non-statutory Double Patenting - 6,712,812**

Claims 12-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,712,812.

Applicant disagrees with this rejection and believes it is made in error. Claim 1 of the '812 patent recites: "A medical device for creating collateral channels in lung tissue."

The Office Action states that the instant application claims are not patentably distinct from the patent because "the use of the device in the patent claims would read on the claimed method, given that the device has a lumen therein."

Again, claim 1 recites "a method of altering gaseous flow in a lung, comprising, locating a site in the lung for creating a collateral channel; creating the channel in an airway wall of the lung; temporarily inserting a conduit into channel; and subsequently removing the conduit after the channel has healed in an open position.

Clearly, the claims of the '812 patent define an invention that is a device for creating collateral channels in lung tissue. In contrast, the subject claims define an invention that is a method of creating a channel, inserting a conduit into the channel, and subsequently removing the conduit after the channel has healed in an open position. In view of these clear differences, applicant requests withdrawal of this rejection.

**Rejections under Non-statutory Double Patenting - 6,629,951**

Claims 12-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,629,951.

Applicant disagrees with this rejection and believes it is made in error. Claim 1 of the '951 patent recites: "A medical device for creating an opening in tissue within the lungs and applying heat to the opening".

The Office Action states that the instant application claims are not patentably distinct from the patent because "the use of the device in the patent claims would read on the claimed method, given that the device has a lumen therein."

Again, claim 1 recites "a method of altering gaseous flow in a lung, comprising, locating a site in the lung for creating a collateral channel; creating the channel in an airway wall of the lung; temporarily inserting a conduit into channel; and subsequently removing the conduit after the channel has healed in an open position.

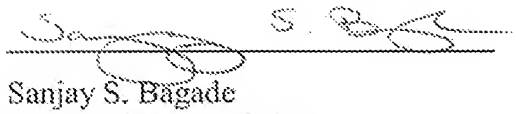
Clearly, the claims of the '951 patent define an invention that is a device for creating an opening in tissue within the lungs and applying heat to the opening". In contrast, the subject claims define an invention that is a method of creating a channel, inserting a conduit into the channel, and subsequently removing the conduit after the channel has healed in an open position. In view of these clear differences, applicant requests withdrawal of this rejection.

## CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections and pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the appropriate fee and/or petition is not filed herewith and the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with this filing to **Deposit Account No. 50-3973** referencing Attorney Docket No. **BRONNE00104**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,



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